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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,109	08/30/2001	Shannon M. Short	36968-259630 (BS01158)	9813
23552	7590	05/20/2005	EXAMINER	
MERCHANT & GOULD PC			CHOW, MING	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	
			2645	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,109

Applicant(s)

SHORT, SHANNON M.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to intelligent billing service control processor, classified in class 379, subclass 114.28.
 - II. Claims 23-30, drawn to usage measurement at subscriber unit, classified in class 455, subclass 407.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I does not require the particulars of the invention I. The subcombination has separate utility such as wireless telephone and digital telephone. The combination also has separate utility such as voice mail.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Murrell Blackburn a provisional election was made with traverse to prosecute the invention of 09/943109, claims 1-22. Affirmation of this election

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must be made by applicant in replying to this Office Action. Claims 23-30 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Objections

5. Claim 1 recites "the time" (line 6). There is insufficient antecedent basis for this limitation in the claim.

Also, claims 1, 17 recite "the user" (line 8). There is insufficient antecedent basis for this limitation in the claim.

6. Claims 6, 12, 13, 14, 16 recite "the step". There is insufficient antecedent basis for this limitation in the claim.

7. Claim 17 recites "the time used by a call" (line 5-6), "the timer usage variable" (line 6), . There is insufficient antecedent basis for this limitation in the claim.

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8. Claim 18 recites “the value”. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 19 recites “the time limit”. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 20 recites "the timer usage variable", . There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 7, 8, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “each timer” is not clearly defined. The “each timer” refers “one of a plurality of timers”. However, claim 1 claimed only one timer without claiming a plurality of timers.

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12. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “at least one beginning date and time and at least one ending date and time” is not clearly defined. It is unclear this limitation refers to “at least one beginning date, and time, and at least one ending date and time”, or “at least one beginning date, and time and at least one ending date, and time”, or “at least one beginning date and time, and at least one ending date, and time”, or other possible limitations.

13. Claims 15, 16, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the timer information” is not clearly defined. It is unclear this limitation refers to “timer information” of claim 1 line 4 or “predefined timer information” of claim 1 line 8.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “receiving a user request for timer information through voice mail” is not disclosed by the specification. The specification, on section [0049] discloses “the timer information is accessed from a voice mail system”. When a voice mail is accessed from a voice mail system the user does not send his request by an voice mail. The specification does not support sending a request for accessing voice mails and the request is sent by a voice mail.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 1-5, 7-13, 17, 18, 20, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhogal et al (US: 2002/0193092).

Regarding claims 1, 3, 17, 18, Bhogal et al teach on section [0019], activating a timer. The timer has date (claimed “a time block designation”) and timer data (claimed “time usage variable”). The timer counts time increments of the call (claimed “adding the time”). Bhogal et al teach on section [0020], the call counts are based on calling plan (claimed “if the call was made within the time block”).

Bhogal et al teach on section [0026], the call count (claimed “predefined timer information”) may be conveyed (claimed “notifying”) to the operator (claimed “the user”).

Regarding claim 2, Bhogal et al teach on section [0028], another call count function (claimed “second timer”) for providing special parameter and calculating the special call count.

Regarding claims 4, 19, Bhogal et al teach on section [0027], the provider offers call time ration (claimed “time limits”).

Regarding claim 5, Bhogal et al teach on section [0027], a remaining call count (claimed “the time limits minus the time usage variable”).

Regarding claims 7, 8, 9, Bhogal et al teach on section [0003], the time count is based on calling plans parameters including peak or off-peak call. It is inherent that the peak or off-peak time must be defined by a beginning time and an ending time.

Regarding claim 10, Bhogal et al teach on section [0026], reset the accumulated call count.

Regarding claims 11, 20, Bhogal et al teach on section [0026], the call count is reset at the beginning of every billing cycle.

Regarding claim 12, Bhogal et al teach the call count may be conveyed via the display (claimed “an electronic message”).

Regarding claims 13, 22, Bhogal et al teach on sections [0009], [0018], computer medium and computer code used by the controller. The controller and associated elements in Fig. 1 of Bhogal et al is a computer network.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhogal et al as applied to claim 1 above.

Bhogal et al teach on sections [0028], [0029], the special call count parameter includes night-time, weekend, peak, or off-peak (claimed “time block information”) and may be input via the keypad.

Bhogal et al failed to teach the time block information is received from the user. However, “Official Notice” is taken that the user of the phone who enters information via the keypad of the phone is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Bhogal et al to have time block information entered by the user such that the modified system of Bhogal et al would be able to support the system users an easy function of defining calling schedule.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhogal et al as applied to claim 1 above, and in view of Chavez (US: 6058305).

Bhogal et al failed to teach “receiving a user request for timer information through voice mail and transmitting timer information to said user through voice mail”. However, Chavez teaches on column 3 line 32-35, a voice mail contains timer information.

It would have been obvious to one skilled at the time the invention was made to modify Bhogal et al to have “receiving a user request for timer information through voice mail and transmitting timer information to said user through voice mail” as taught by Chavez such that the modified system of Bhogal et al would be able to support the system users a different method of accessing timer information.

18. Claims 15, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhogal et al as applied to claim 1 above, and in view of Joyce et al (US: 6320947).

Bhogal et al failed to teach “protecting the timer information with a user password”. However, Joyce et al teach on column 13 line 23-51, the “talk time left” information is protected by a PIN.

It would have been obvious to one skilled at the time the invention was made to modify Bhogal et al to have “protecting the timer information with a user password” as taught by Joyce et al such that the modified system of Bhogal et al would be able to support the system users a secure method of protecting timer information.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhogal et al as applied to claim 1 above, and in view of Matsuzaki et al (US: 6289314).

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Bhogal et al failed to teach “charging a fee to access the timer information”. However, Matsuzaki et al teach on column 2 line 42-48, user access pay information and the information provider charges the user. Matsuzaki et al is silent that the “pay information” is “timer information”. However, the content of information is a “decide choice”.

It would have been obvious to one skilled at the time the invention was made to modify Bhogal et al to have “charging a fee to access the timer information” as taught by Matsuzaki et al such that the modified system of Bhogal et al would be able to support the system users to pay for what they get.

Conclusion

20. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Henon (US: 6577717) teaches broadcasting of different tariff periods in a telephone system.

21. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703)

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305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

Ming Chow



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